

REMARKS

The present amendment is submitted in response to the Office Action dated January 17, 2007, which set a three-month period for response, making this amendment due by April 17, 2007.

Claims 1-2 and 4-17 are pending in this application.

In the Office Action, the drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Claims 6 and 13 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-11 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,840,762 to Kasabian. Claims 12 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kasabian in view of U.S. Patent No. 6,296,427 to Potter et al.

Turning first to the objection to the drawings, the Applicant respectfully submits that the subject matter and scope of claim 13 can be seen clearly in Figs. 2b and 2d. In Fig. 2b, the lines of reference numeral 22 point in two different regions of the group 28. These regions represent ribs 22 mounted into a plate. These two regions have different widths as recited in claim 13. In addition, as shown in Fig. 2d, the opening 14 has different diameters. It has a smaller diameter in the front part and a broader diameter in the rear side. An opening 14 with different diameters in it is arranged in the group 28, and therefore, the scope of claim 13 is disclosed in the figures.

Looking next at the rejection under Section 112, second paragraph, the Applicant respectfully directs the Examiner's attention to the specification at page 7, lines 9-13, where the term "elements" is defined as elements in the housing which are arranged in the flow path of the coolant between a coolant inlet and a coolant outlet. In addition, claim 6 recites the feature that the elements are at least in some regions embedded in a casting composition. In the above-referenced paragraph in the specification, it is clearly disclosed and defined that the embedded elements refer, for example, to struts of a switch, which also is shown in Fig. 3.

Therefore, the term "elements" refers to components which are located in the housing and in the flow path of the coolant between a coolant inlet and a coolant outlet as struts of a switch and the like.

At least one object of the present invention is to provide a power tool with a coolant duct arrangement, in which due to the design of the coolant duct, a comfortable noise reduction could be achieved. Therefore, as defined in claim 6, it is advantageous to embed elements like struts of a switch in a casting composition to prevent sharp edges and, in turn, the appearance of noise (see specification, page 2, lines 26-30 and Fig. 3). An embedding is only necessary in some regions of the elements, because the coolant flow passes only parts of the elements which are arranged in the coolant duct. As disclosed in the specification on page 7, lines 5-7, components are arranged in the housing which are partitioned off by a closed region of the housing and, therefore, do not require

an aerodynamic design like the embedding in a casting composition to prevent the appearance of noise.

Claim 6 was amended to positively recite the elements 20. The Applicants respectfully submit that this amendment and the above explanation and references to the disclosure address and obviate the rejection of claim 6 under Section 112, second paragraph.

With regard to the rejection of claim 13 under Section 112, second paragraph, as recited in claim 5 and disclosed on page 2, lines 22-24, as well as on page 6, lines 28-30, and as shown in Fig. 2b, the openings are embodied as round or cylindrical, respectively. Therefore, the openings 14 are clearly defined as being round. The Applicant therefore submits that no amendment to claim 13 is necessary.

Turning next to the substantive rejections of the claims, claim 1 has been amended to add the feature of claim 3, which was canceled. Specifically, amended claim 1 now defines that the through openings are located in a plate which is joined to the housing.

In addition, new claim 15 has been added, which includes the features of claim 7 and features shown in Figs. 1, 2a, and 3 and disclosed on page 6, lines 4-5, as well as page 2, line 16, of the specification.

New claim 16 also was added, which depends on claim 7 and includes features disclosed in the specification at page 6, lines 28-30 and shown in Figs. 1, 2b, and 3.

Finally, new claim 17 has been added, which depends on claim 1 and includes features shown in the figures, in particular, Fig. 2a.

The Applicant respectfully submits that the new and amended claims define patentably distinct set of features that are not shown or suggested by the cited reference combinations.

The primary reference to Kasabian et al discloses a power tool with an electric motor and an internal flow system, in which the internal flow system provides cooling for the motor (Kasabian, Fig. 3 and abstract). Inlet means are arranged at one end of a casing 22 in a filter screen 112 of a filter 102, through which air can flow into the casing 22 (Kasabian, Figs. 1 and 3; column 4, lines 8-17; claim 1).

In contrast, the present invention provides a power tool, such as a handheld power tool, with a coolant duct arrangement with through openings 14, 14' for a cooling medium for cooling the motor and a cooling duct arrangement with through openings 14, 14' for a coolant (application, Figs. 1, 2b, and 3; specification, page 1, lines 21-23). The through openings 14, 14' are located in a plate, which is joined to a housing 10 (specification, page 2, line 16 and page 5, lines 4-5; Figs. 1 and 2a). Therefore, the plate with the through openings 14, 14' can be seen as a separate and replaceable component of the power tool or the coolant duct arrangement, respectively, which can be adapted individually to a device and optimized for that use.

Kasabian fails to disclose an arrangement of the inlet means in a separate and replaceable component. Rather, the inlet means are located in a filter

screen 112, which is mounted by means of several components (seal 110, recess 116, filter mount 56, cover 114, studs 118, and nuts 120) to the power tool.

Kasabian teaches arranging inlet means in a filter screen 112 of a filter 102 at one end of a casing 22 (Kasabian, Figs. 1 and 3; column 4, lines 8-17 and claim 1). The filter screen 112, which embodies the inlet means, is not constructed as a plate, as with the present invention. Due the arrangement of the through openings 14, 14' in a plate, the coolant inlet and the coolant outlet, respectively, can be adapted individually to a device and optimized for that use (see specification, page 2, lines 16-17). Furthermore, the plate can be replaced easily without a great number of changes in the construction of the power tool.

Kasabian does not provide any suggestion or motivation to the practitioner for arranging the inlet means in a plate.

The cited reference to Potter disclose a drill 10 with a housing 12, in which the housing 12 includes slits 62, 64, which provide air passage between ambient and a motor 14 to cool the motor 14 (Potter, Fig. 1; column 3, lines 52-54). The slits 62, 64 are not arranged in a plate, which could be seen as a separate component of the power tool. Rather, the slits 62, 64 are included in the housing 12. As with Kasabian, Potter likewise provides no suggestion or motivation to the practitioner for arranging the slits 62, 64 in a plate.

Because neither Kasabian nor Potter discloses or suggest providing slits or openings in a plate, which is a separate component of the power tool, the combination of these references does not render obvious the

subject matter of claim 1. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01.

For the reasons set forth above, the Applicant respectfully submits that claims 1-2 and 4-17 are patentable over the cited art. The Applicant further requests withdrawal of the rejections under 35 U.S.C. 103 and reconsideration of the claims as herein amended.

In light of the foregoing amendments and arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

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